

1
2
c:7
Comel.

18
16.

(New) The method of claim 13, wherein said user selection of a displayed station name is effected by user operation of a pointing device.

REMARKS:

Claims 1, 7, 8, 10, 12, 13 have been amended and new claims 14-16 have been added. No claims have been cancelled. Claims 1-5, and 7-16 are now pending in the application. Consideration is requested taking into, account the amendments and the following comments.

Claims 1, 2 and 5 have been rejected under 35 USC 103 as allegedly unpatentable over an Internet article dated August 21, 1996, "Destination Features" (Internet Article I) in view of US Patent 4,959,720 (Duffield) and further in view of US Patent 4,706,121 (Young). The Office Action concedes that Internet Article I and Duffield fall short of teaching the invention as claimed in claim 1 or claim 2. In attempting to remedy this shortcoming, the Office Action cites Young on the basis:

" . . . it would have been obvious for one of ordinary skill in the art to modify Internet Article I and Duffield by the teachings of Young at the time the invention was made so that a viewer may simply key in the call name without expending additional time and energy programming in the call names."

This conclusory opinion lacks factual support in, and contradicts the teachings of, the cited references and is respectfully traversed.

Duffield was not only fully aware of Young but highlighted a perceived deficiency of Young in the following terms:

" . . . Young provides no means by which the user can enter labels of his own choosing, either for display of for selecting a channel." (Duffield, col. 2, lines 15-18)

This evaluation of Young by Duffield is explicitly substantiated by Young's disclosure of a user input keypad 220 comprising control keys 222-244 and "digit keys" 246 numbered "1" through "0". No text entry keys are provided in Young's keypad 220. In Young, to enter a channel in a stored list, a user is required to "*press the digit keys 246 and enter using the SEL key 228. All single digit channels must be preceded by 0.*" (Young, col. 14, lines 55-57, emphasis added.) To select a program directly from the listing Young teaches

[t]he keyboard 220 may be used as a conventional TV selector by pressing the digit keys only, . . . [E]ach time that a new channel is selected, a channel number will appear on the bottom line of the screen. If a service name is associated with a signal received on a particular channel, the channel name will be displayed rather than the channel number. Thus, if channel 3 is HBO, HBO will be displayed. (Young, col. 10, lines 19-28, emphasis added.)

Thus, regardless of the teaching of Duffield, Young neither teaches or suggest any modification of Duffield that would have led to the invention claimed in claims 1 and 2.

More fundamentally, Duffield's system is distinct from that claimed in the claims of the present application. Duffield teaches a tuning system in which a user enters and stores in RAM text labels associated with particular channels for later use in a tuning operation. During a tuning process, a user entered label which completely matches a stored station label results in automatic system tuning to that station without user intervention - Duffield col 8, lines 1-13. There is no teaching or need in Duffield of "*depicting on said monitor a list of user defined network names which most closely match the text as it is being entered by the user*" which is a requisite of claims 1 and 2. Thus, the teachings of both Duffield and Young are not only distinct from each other, as recognized by Duffield, but also both are divergent from the invention claimed in claims 1 and 2, and neither reference is seen to contain teaching that would have led a person skilled in the art to the invention as claimed in claim 1 or claim 2.

For completeness, the comments bridging pages 3 and 4 in the Office Action are noted as being presented in the present tense, whereas the pertinent consideration is what was known in the art at the time of the claimed invention. Thus, apart from the deficiencies in the cited art noted above, the overall rejection is based on three documentary cited references which

supplemented by a fourth unsubstantiated feature characterized as “well known in the art” collectively fail to reach or even approach the invention as claimed in claim 1 or claim 2 of the application. This is further substantiation that the invention claimed in claims 1 and 2 of the present application are patentable over the cited references.

Claims 3 and 4 have been rejected under 35 USC 103 as allegedly unpatentable on the same grounds as claim 1, supplemented by yet a further reference, “The Big-Tube PCTV” (May 28, 1996), (Internet Article II). This rejection is traversed for the same reasons advanced in respect of claim 1. Internet Article II does not show or suggest how to modify any of the primary references in a manner that would have lead to the combination features required by claim 3 or claim 4. That the Internet Article II PCTV system is stated to have a television mode, or is operable in a computer mode with a TV window is immaterial. The fact is that the cited collection of references fails to teach or suggest either that “*said channel macro [in the system of claim 1] is implemented when said computer system is in a TV mode*” (claim 3) or that “*said channel macro [in the system of claim 1] is implemented when said computer system is in a computer mode and a video window is an active window*” (claim 4). Claims 3 and 4 are independently patentable over the cited references.

In rejecting claim 7 under 35 USC 103, the Office action relies on US Patent 5,379,454 (Takegawa) in an attempt to compensate for the deficiencies of the three primary references used to support the rejection of claim 1. Again, this collection of four references still fails to result in or to suggest the combination of features required by claim 7. Takegawa teaches a digital synthesizer tuner wherein in whole or part name matching of a user entry with a stored broadcast station name results in automatic system tuning to a radio station, but does not disclose or suggest display of a channel name for user selection. Likewise, as noted above, Duffield teaches a tuning system in which a user enters and stores in RAM text labels associated with particular channels for later use in a tuning operation. During a tuning process, a user entered label which completely matches a stored station label results in automatic system tuning to that station without user intervention - Duffield col 8, lines 1-13. There is no teaching or need in Duffield or Takegawa of a “*channel macro [which] provides the user a best guess of*

potential networks based on the alphanumeric key presses as they are being made by the user and tunes said television to a user selected one of said best guess of potential networks” which is a requisite of claim 7. (See applicant’s specification, page 13, line 12 - page 14, line 5 and Fig. 2. steps S200, S212, S214, S208, S210, S218, S220, S222.) Claim 7 is patentable over the cited references and Schindler (cited in the accompanying Information Disclosure Statement); the teachings of both Duffield and Takegawa are divergent from the invention claimed in claim 7, and neither reference is seen to contain teaching, even taking into account the other cited references, that would have led a person skilled in the art to the invention as claimed in claim 7.

Claims 1-5 and 7 are each patentable over the cited references and Schindler (cited in the accompanying Information Disclosure Statement).

Attention is drawn to the recent comments by the CAFC in *In re Kotzab* 55 USPQ2d 1313 (CA FC 2000), quoted in pertinent part:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 U.S.P.Q.2D (BNA) at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 313 (Fed. Cir. 1983)).

*Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2D (BNA) 1453, 1457 (Fed. Cir. 1998). Thus, every [*10] element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 U.S.P.Q.2D (BNA) 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733*

F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996).

The rejection of each of claims 1-7 appears based on use of improper hindsight analysis attempting to identify individual claim features in multiple references using the claims under rejection as a source, rather than from any suggestions or teachings in any of the cited prior art references.

Claims 8 and 13 are asserted in the Office Action to be “the method claims of system claims 1-5, 7.” If this intended to assert that either of claims 8 and 13 have the same scope as any of claims 1 -5, 7, this assertion is not correct and is not supported by the language of the claim 8 or claim 13. The rejection of claims 8 and 13 “for the reasons given with respect to claims 1-5,7” is traversed, based on the deficiencies of the cited references as pointed out in the above rebuttal of the rejections of claims 1-5, and 7. Again, it is noted that the Office Action admits that the five (5) documentary references (i.e. those cited against claims 1-5 and 7), do not meet the combination of features recited in claim 8 or claim 13 by additionally asserting (but not substantiating) a claim feature not disclosed or suggested by the cited references is (whereas the proper consideration would be “was”) “*extremely well known and commonly used in the art.*” For example, the cited references fall short of disclosing or suggesting:

pressing a first alphanumeric key on said keyboard; determining whether said first alphanumeric key designates a character which is a first character in one or more predetermined network station names [stored by a manufacturer]; displaying the or each said network station name containing a said matching first character on said monitor; and tuning to network station corresponding to a user selected displayed network station name. (claim 8)

or

pressing a first alphanumeric key on said keyboard; determining whether said first alphanumeric key is a first character in at least one predetermined network station name [from a data base of network station names in said PC/TV computer system prior to providing said PC/TV computer system to a buyer]; displaying said at least one network station name on said monitor; user selecting one network station name from among said at least one network station name displayed on said monitor; and said PCTV computer system tuning

to a channel associated with said network station in response to said user selection. (claim 13).

Claims 8 and 13 are patentable over the cited references and Schindler (cited in the accompanying Information Disclosure Statement).

As to claims 9, 10, 11 and 12, the Office Action relies on features of cited references (or features asserted to be "well known") considered in isolation, i.e. not in the context of the overall system disclosed by the corresponding cited reference incorporating those features. This "out of context" reliance does not render a claim unpatentable merely because that claim may include one or more of such features. A rejection may not properly be predicated on the mere identification in individual references of individual components of claimed limitations. The features relied on in each cited reference in rejecting a claim must be considered in the context of the teaching of the entire reference. What is pertinent is whether or not the cited references, each considered as a whole, would have suggested modification of one reference by one or more of the other references that would have led to the claimed combination considered as a whole. Such a result does not result from the analysis of the cited references contained in the Office Action nor from a fair consideration of the cited references themselves, but rather, again, from improper hindsight analysis to which the previous comments made with reference to claims 1-7 are applicable. Claims 9-13 are patentable over the cited references and Schindler (cited in the accompanying Information Disclosure Statement).

Newly added claims 14 is directed to a method of selecting a network station in the claim environment, which includes the steps of:

in sequence, user actuation of one or more alphanumeric keys on said keyboard to enter one or more text letters and determining whether the or each entered text letter matches a letter in the corresponding sequence in one or more of said predetermined network station names [from a data base of network station names in said PC/TV computer system prior to providing said PC/TV computer system to a buyer]; displaying on said monitor each network station name including said matched letters as said letters are being entered by a user; and then tuning a network stations corresponding to one of said displayed station names in response to user selection of that displayed station name.

None of the cited references discloses or suggests such a combination of steps. Claim 14 is patentable over the cited references and Schindler (cited in the accompanying Information Disclosure Statement), together with its dependent claims 15 and 16.

CONCLUSION:

It is believed that each of claims 1-5 and 7-16 has been shown to be patentable over the cited references and that those claims are in condition for allowance. Early action to that effect is solicited.

If telephone discussion would expedite further prosecution of this application, a telephone call to the undersigned attorney at 972-490-3695 would be appreciated.

Respectfully submitted,



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